

REMARKS

In the Office Action mailed 8/9/2005, Claims 1-11, 12 and 15-18 were rejected as being anticipated under 35 U.S.C. §102(b). Claims 13, 14, 19 and 20 were rejected as being obvious over the prior art under 35 U.S.C. §103(a). A provisional double-patenting rejection was issued for claims 1-20.

In response, Applicant has submitted proposed amendments to Claims 1, 2, 4, 12 and 15 in view of the prior art, as discussed below. Applicant has further canceled Claims 11, 13-14, and 16

For the reasons set forth below, reconsideration of the rejections is requested and allowance of the present application is submitted to be in order.

Applicant's Amendment necessitated the new grounds for rejection

In his Office Action, the Examiner has exclusively relied upon three references that first became of record in this case in that 8/9/05 Office Action. Although he indicates that these references were "of record" in this matter, he is incorrect, and in fact only made these references of record in the PTO-892 that accompanied the 8/9/05 office action (see footer of PTO-892). This presents two problems: (1) he has made this rejection final based upon three references that have never been part of the record in this case, and therefore, has improperly made his rejections final on a first office action; and (2) he concludes that Applicant's Amendment necessitated the new grounds for rejection without providing any substantiation, evidence or even argument to support such conclusion. As such, Applicant respectfully asserts that at the very least, the finality of these rejections must be withdrawn

and the Examiner must issue an Office Action anew allowing for a full discourse over the significance of these references for the record.

Furthermore, since the Examiner was the examiner of record in the *Kaise* application, clearly he was aware of its pertinence to the patentability of Applicant's disclosed invention, he should be bound by his failure to rely on that reference in his first action.

Anticipation Rejections under 35 U.S.C. §102(b)

Kaise, U.S. Patent No 6,062,986

This reference is cited by the examiner as anticipating Claims 1 and 15-18. Applicant respectfully traverses this rejection as it applies to independent Claim 1, as proposed amended, since *Kaise* fails to disclose the following recited structure: "a generally cylindrical wall having a curved cross-section said top surface and an underside surface, said cylindrical wall having a larger cross-sectional diameter at a face end and a smaller cross-sectional diameter at an opposing end." Nor does *Kaise* disclose "said planar alignment means further comprising a linear slot associated with said club oriented perpendicular to said face, said slot too thin to view more than a single line inscribed on said projection surface, said upper member is non-hemispherical" of Applicant's Claim 15.

Since these limitations are not recited by *Kaise*, each and every element of Applicant's claimed invention cannot be found in *Kaise*, and this ground for rejection must be withdrawn.

Applicant also respectfully points out that Kaise, in failing to disclose the “cylindrical wall” nor the “thin slot” is unworkable as compared to Applicant’s claimed invention, since these structures add to the user’s ability to align the club head with the ball and hole, improves the paralactic alignment of the golfer’s head with the club by providing a longer alignment area, creates a more aesthetically pleasing product, and also provides a club head that is more evenly weighted than is Kaise. As such, Kaise also fails to suggest Applicant’s claimed invention, and in fact teaches away from the claimed structure.

Innes, U.S. Patent No 5,275,412

This reference is cited by the examiner as anticipating Claim 12. The Examiner, however, has failed to make out any case to support his conclusion. In fact, only cursory review of Innes reveals that the following limitations are not found in this reference:

“said top surface further comprises at least one darkened portion of said surface adjacent to said slot; and

said projection surface further comprises a lightened portion.”

Innes has no darkened or lightened portions. In fact, looking through the Innes slots (7) results in a view of the base of the club shaft (6) where it attaches to the club head. There is no disclosure or hint of colored or shaded portions on the “top surface” or the “projection surface.”

Since these limitations are not recited by Innes, each and every element of Applicant’s claimed invention cannot be found in Innes, and this ground for rejection must be withdrawn.

Obviousness Rejection under 35 U.S.C. §103(a)

Here, as discussed above, Applicant respectfully asserts that his amendment did not necessitate the new grounds for rejection over Hamilton, in view of Kaise and therefore the finality of this ground for rejection should be withdrawn.

Hamilton, U.S. Patent No. 4,343,472

Claims 19 and 20 are rejected as being obvious under 35 U.S.C. §103(a) over the combination of Hamilton and Kaise. Neither Hamilton nor Kaise disclose the claimed “generally cylindrical wall having a curved cross-section said top surface and an underside surface, said cylindrical wall having a larger cross-sectional diameter at a face end and a smaller cross-sectional diameter at an opposing end.” of Claim 1 (from which claims 18, 19 and 20 depend). Hamilton, in contrast has a upwardly-turned triangular shape, and Kaise has an “upper face” of the club head that is only attached at its front (club face) side, and its rear end is free and is cantilevered over the bottom of the club head.

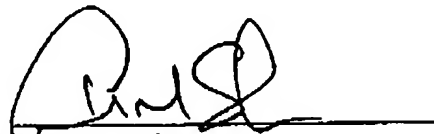
Nothing in either Hamilton nor Kaise suggest Applicant’s claimed structure, either alone or in combination, and therefore the prima facie case of obviousness has not been made out, and this ground for rejection should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue. If any impediment to the allowance of the claims remains after consideration of this request for reconsideration, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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